

Application No.: 09/966557

Case No.: 55871US002

**Remarks**

This communication is responsive to the Office Action mailed on November 16, 2004. Claims 1-26 are currently pending. Reconsideration of the above-referenced application in view of the following remarks is respectfully requested.

**Objections to the August 17, 2004 Amendment**

In response to the Examiner's objections in connection with claims 10 and 12, the Applicants hereby submit a replacement copy of the August 17, 2004 Amendment, in which inconsistencies between the claim status and markings therein have been reconciled and in which page 1 is in proper form.

**§ 103 Rejections**

Claims 1-4, 6-12, and 18-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application Publication No. 0487047 to Shingaki et al. (hereinafter "Shingaki") in view of U.S. Patent No. 2,285,792 to Bailey (hereinafter "Bailey"). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shingaki in view of Bailey. Claims 5 and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shingaki in view of Bailey and further in view of U.S. Patent No. 5,986,730 to Hansen et al. (hereinafter "Hansen"). The Applicants hereby traverse these rejections and respectfully submit that all currently pending claims are patentably distinguishable over Shingaki, Bailey and Hansen.

Concerning 35 USC § 103(a) rejections, § 2141 of MPEP recognizes the following basic considerations that apply to obviousness rejections:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986). (emphasis added).

MPEP § 2141.02 further specifies that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention, as stated in *W.L.*

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*Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In evaluating obviousness, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP § 2142. Further, as set forth in MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaek*, 947 F.2d 488 (Fed. Cir. 1991).

Furthermore, as stated in MPEP § 2143.01, if the proposed modification or combination of the prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Applicants respectfully submit that none of the cited references, alone or in combination, disclose all elements of any of the claims. For example, none of the cited references teach or suggest a film that includes a polarizer element and a separate polarization rotator element that are integrated to form a single film as required by the pending claims.

In the November 16, 2004 Office Action, the Examiner has acknowledged that Shingaki does not contain "an explicit teaching wherein said polarizer element and the separate polarization rotation element are integrated to form a single film." Indeed, Shingaki teaches an optical modulating device including a freestanding pair of transparent base boards with a liquid crystal layer provided therebetween, the base boards being interposed between the polarizer (1) and the halfwave plate (5). Furthermore, Shingaki teaches that the halfwave plate (5) is physically rotated around the optical axis of the light coming into the optical modulating device. The rotational angle of the halfwave plate is varied in accordance with the temperature of the liquid crystal layer.

The Examiner then turns to Bailey stating that it contains a "teaching of a polarizer element and a separate polarization rotation element being integrated to form a single film (cf. Fig. 2 of the instant invention and Figs. 1-3 of Bailey)." The Applicants respectfully disagree

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and submit that Bailey neither discloses nor suggests the combination of a polarizer and a separate polarization rotation element as claimed in the present application. Instead, Bailey is directed to systems for changing eccentricity of elliptically polarized light, and, more particularly, for obtaining circularly polarized light from plane polarized light. (See, e.g., p. 1, col. 1, lines 14-18). Thus, Bailey is not concerned with polarization rotation (see p. 3, col. 1, lines 35-44).

The Applicants further submit that neither the cited references nor knowledge generally available to one of ordinary skill in the art would provide a suggestion or motivation to combine the cited references to arrive at the Applicants' invention with a reasonable expectation of success. In fact, the proposed combination of Shingaki and Bailey would render the prior art devices being modified unsatisfactory for their intended purpose. For example, attaching the polarizer (1) to the halfwave plate (5) would render the modified device unsatisfactory for its intended purpose, because the device of Shingaki requires physically rotating the halfwave plate in correlation with the temperature variations in the liquid crystal layer. Thus, one of ordinary skill in the art would not be motivated to combine the disclosures of Shingaki and Bailey.

Therefore, for at least the foregoing reasons, the Applicants submit that the present claims 1-26 are patentable over the cited references and an office action acknowledging the same is respectfully requested. In view of the above, it is submitted that the application is in condition for allowance, which action is earnestly solicited. If after reviewing this amendment and response, should the Examiner have questions or require additional information, the Examiner is cordially invited to call the undersigned attorney.

Respectfully submitted,

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Date

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